

Remarks

Claims 16-23 and 46-50 are pending. The Office action of June 8, 2005 rejects claims 16-23 and 46-50 under the judicially created doctrine of double patenting over claims 1-30 of U.S. Patent No. 6,415,334 [“the ‘334 Patent”], alleging that “Although the conflicting claims are not identical, they are not patentably distinct from each other because there is no feature in any of the present claims that is not obvious in view of claims 1-19 of the ‘334 patent.” Applicants respectfully traverse the rejection.

The Office’s current position that the claims are not patentably distinct is inconsistent with the Office’s previous position with respect to these claims. The pending claims 16-23 and 46-50 of the present application and claims 1-30 of the ‘334 Patent were presented together in a single application, i.e., the parent application, U.S. Patent Application Serial No. 08/856,136, filed May 14, 1997, which is now the ‘334 Patent. In that original patent application, the Office made a restriction requirement between three groups of claims as summarized in the Office action, mailed December 19, 2000, asserting that these three claim groups addressed separate and distinct inventions. Due to the Office’s own restriction requirement, Applicants therefore elected a group which became claims 1-30 of the ‘334 Patent and filed the present divisional application separately. Accordingly, there was clear reason why Applicants are prosecuting the instant claims separately from those of the ‘334 Patent – the Office restricted Applicants from so doing.

Because the claims 16-23 and 46-50 of the present application and claims 1-30 of the ‘334 Patent were subject to a restriction requirement, and subsequently claims 16-23 and 46-50 were presented in a divisional application, the issued ‘334 patent cannot properly be used as a reference against the present application. (*See*, 35 U.S.C. § 121, which states, “A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.”) This § 121 prohibition against use of divisional applications or patents against each other applies in this case because claims 15-18, and 46-50 in the instant application retain the exact language that was asserted by the office to distinguish from the other two claim groups (including the claims 1-30

issuing in the '334 Patent), and thus all remain consonant with the restriction requirement. (See, MPEP § 804.01(B).) Additionally, although claim 19 was amended in a preliminary amendment, the amendment added language to the claim and did not delete any language other than the word "the." Thus the amendment to claim 19 did not remove any language asserted by the Office to distinguish from the other two claim groups, and so claims 19-23 also retain the distinguishing language and remain consonant with the restriction requirement.

The Office's rejection under § 121 therefore is improper, and should be withdrawn.

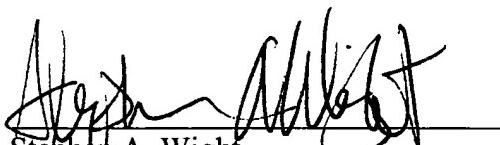
Conclusion

The application should now be in condition for allowance. Such action is respectfully requested.

Respectfully submitted,

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